

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of: Richard J. McCann)	
Serial Number: 10/772136)	GAU: 3724
Filed: February 4, 2004)	
For: Locking Folding Knife with Gas Spring)	
)	Examiner: Landrum, Edward F.
Not. of Appeal Filed: November 10, 2006)	
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To the Board:

REPLY BRIEF

On Appeal from the Final Office Action dated August 11, 2006, please consider the following Reply Brief:

§ 103(a) Rejection Based on Collins and Poehlmann

The Examiner asserts the present invention to be obvious because Collins teaches a folding knife including a locking mechanism biased by “a spring or other biasing mechanism” in a chamber and Poehlmann recites a laundry list of seven potential biasing means, including a pneumatically forced system.¹ The Examiner simply dismisses all secondary considerations of non-obviousness and relies on this gross simplification of the matter to reject the present application.

Poehlmann Does Not Suggest a Structure or Advantage for Using a Pneumatic Means

The Examiner did not properly respond to the argument that Poehlmann does not suggest how to adapt or an advantage to using a pneumatic biasing means over the disclosed helical spring embodiment or how such an alternative might be combined into the very different bolt lock knife of Collins. According to the Examiner, Poehlmann “teaches that it [is] old and well

¹ Collins, US Patent # 4,451,982, col. 3, lines 31-33. Poehlmann, US Patent # 5,964,035, col.8, lines 31-35.

known to replace a metal spring with a gas spring to be used for the same purpose making the metal spring of Collins and the gas spring of Poehlmann functional equivalents.”² This is a broad assumption to make from a single sentence of the Poehlmann patent: “A biasing or urging means other than a helical spring can be provided such as . . . hydraulic or pneumatically-forced systems.”³ This sentence does not teach a gas spring positioned to bias a latch member into the locked position, the gas spring comprising a movable wall that partially defines a substantially sealed, variable volume chamber, claimed in the present application. Poehlmann also does not teach how the chamber of Collins could be converted into a gas spring or whether an entire gas spring would be located inside the chamber. This sentence in Poehlmann attempts to teach a hydraulic-forced system, when a hydraulic spring is a physical impossibility.⁴ A few words in the Poehlmann patent, part of a “kitchen sink” paragraph reciting everything the inventor can imagine (physically possible or not), are not sufficient to render the present invention obvious.

Poehlmann states that different biasing means could potentially replace the helical spring and merely offered a “hydraulic or pneumatically-forced system” with no discussion of why a different means may be advantageous or how such a system could be adapted.⁵ Case law indicates that a combination of references is less likely to be obvious if some suggestion of advantage is not present in the prior art.⁶ The lack of such a suggestion provides support to the

² Examiner’s Answer, page 4.

³ Poehlmann, US Patent # 5,964,035, col. 8, lines 31-35.

⁴ See Declaration of McCann

⁵ Poehlmann, US Patent # 5,964,035, col. 8, lines 31-35.

⁶ See *In re Sernaker*, 217 USPQ at 6 (“The lesson of this case appears to be that prior art references in combination do not make an invention obvious unless something in the prior art references would suggest the advantage to be derived from combining their teachings.”). After *KSR Int’l. Co. v. Teleflex, Inc.*, No. 04-1350 (U.S. Apr. 30, 2007), the “teaching, suggestion, or motivation” test is no longer a rigid requirement for non-obviousness, but remains a provider of helpful insight in determining obviousness. In the present case, a lack of a suggested advantage advises that the combination is not obviousness.

Applicant's claim that the presently claimed combination is non-obvious.

Objective Evidence of Non-Obviousness

The Supreme Court revisited the issue of obviousness in the recent case of *KSR Int'l. Co. v. Teleflex, Inc.*, No 04-1350 (U.S. Apr. 30, 2007). In the case, the Court reaffirmed the *Graham* factors in the determination of obviousness, including evaluating evidence of secondary consideration.⁷ This affirmation was supported by the May 3, 2007 memo from Margaret Focarino, Deputy Commissioner for Patent Operations, to the Technology Center Directors.⁸ Recent events thus reinforce the importance of evaluating evidence of secondary consideration in determinations of obviousness.

The presence of evidence of secondary consideration can be the most probative evidence of non-obviousness available and helps avoid the trap of hindsight.⁹ Importantly, *KSR* affirms that a rejection based on hindsight is improper. Objective evidence of non-obviousness includes, but is not limited to, (a) commercial success of the claimed invention, (b) long felt but unsolved needs, and (c) failure of others.¹⁰ These secondary considerations suggest a finding of non-obviousness if the matter is otherwise doubtful.¹¹

The Examiner dismisses evidence of secondary consideration, the statements and declarations of Richard McCann and five prominent members of the knife community, because “the members of the knife community who provided the affidavits for the instant application do not make up the *entire* knife community or the entire group of people that would be considered

⁷ *Graham v. John Deer Co.*, 383 U.S. 1, 17, 148 U.S.P.Q. 459, 467 (1966).

⁸ See attached memo.

⁹ *Custom Accessories Inc. v. Jeffery-Allan Indus. Inc.*, 1 U.S.P.Q.2d 1196, 1199 (Fed. Cir. 1986).

¹⁰ *Graham v. John Deer Co.*, 383 U.S. 1, 17, 148 U.S.P.Q. at 467.

¹¹ See *In re Sernaker*, *supra* note 6.

to have ordinary skill in the art.”¹² The statements and declarations in the present case represent individuals with exceptional knowledge and skill in the art and should not be dismissed lightly. A person of ordinary skill in the art of knife design is likely to be a general machinist with little or no specialized training in knife design, but with several years of hands-on experience.¹³ The skill of the individuals who submitted declarations is magnitudes greater and represents significant expertise the practical aspects of knife design and broad knowledge of the cutlery community.¹⁴ If the Examiner’s rationale is followed, individual expertise would not matter and declarations would not provide meaningful evidence of non-obviousness unless every single individual having ordinary skill in the art of knife design were surveyed! There is no requirement that every member of a given community provide declarations in order for the declarations to be meaningful and relevant. Consequently, the declarations and statements should be allowed to play their proper role and fully considered as objective evidence of non-obviousness.

The Examiner uses inappropriate legal standards several times during the rejection of this application. In discounting the objective evidence of non-obviousness filed by the Applicant, the Examiner argues that the declarations fail “to provide convincing reasons that indicate Collin’s knife as modified above is not capable of performing the same function as the folding knife of the instant invention.” This is a rejection premised solely on inappropriate hindsight and relies on an improper legal standard. The Examiner further argues that the declarations “fail to provide convincing reasons why Collin’s folding knife cannot be modified by Poehlmann’s disclosed

¹² Examiner’s Answer, page 6 (emphasis added).

¹³ See Declarations of McCann and Karwan.

¹⁴ See Declarations of Covert, Cutshaw, Karwan, and McCann and Statements of Breed and Larsen.

pneumatic spring.” The appropriate legal standard is not whether it is *possible* to modify a device in the prior art and, furthermore, Poehlmann does not provide enabling disclosure of a pneumatic spring adaptable to the claimed use and structural environment. The Applicant informed the Examiner of the inappropriateness of the legal standards of these rejections in the Appeal Brief, but the Examiner chose to ignore the notice and reuse the same rejections in the Examiner’s Answer.

Failure of Others

The Collins patent issued over 23 years ago. Despite the availability of this folding knife design and the known limitations of metal springs, no one prior to the present inventor has substituted a gas spring into this design in order to overcome this known shortcoming.¹⁵ The Examiner responds to this indication of non-obviousness by referring to imaginary applicants and rejections, stating “prior art of record, or even prior art not of record, may have been used in the past to reject similar knives with gas springs, and it does not mean that other inventors have not tried to receive a patent on a similar device.”¹⁶ This statement is made with no support whatsoever. There is no evidence in the record that any other inventor has ever made or tried to patent a folding knife with a gas spring. There is significant and credible evidence, in the form of the Applicant’s declarations and statements, that no other inventor has ever made a knife as set forth in the claims. The Examiner again dismisses this objective evidence of non-obviousness on the improper grounds that the individuals who submitted declarations do not encompass the *entire* knife community – an impossible standard for which there is no basis in law. The failure of others to produce a folding knife with a gas spring as claimed must be

¹⁵ See Declarations of Covers, , Karwan, and McCann and Statements of Breed and Larsen.

¹⁶ Examiner’s Answer, page 5.

accounted as evidence of the non-obviousness of the present invention.

Long Felt Need

Objective evidence of a long felt but unsolved need is strong in this case. The Examiner argues to the contrary, stating “there appears to be no evidence of any long felt need for a gas spring in a folding knife as there is no evidence of any failure of others to do so.”¹⁷ The Examiner asserts there is no evidence of an unsolved need and no evidence of a failure of others by dismissing the Applicant’s declarations which describe such a need and such a failure. Moreover, the supporting declarations clearly and specifically identify and connect the presently-claimed features as the solution to the long-standing problem. To reiterate what was stated above, declarations cannot be dismissed simply because every single member of a community did not submit one. The declarations may not describe a long felt need for a folding knife with a gas spring *per se*, but they do describe a need for a folding knife with a spring which will not succumb to fatigue or corrosion – the specific shortcomings of the prior art.¹⁸ The declarations clearly assert that no folding knives with gas springs have been made by others.¹⁹ The present invention, as set forth in the claims, fulfills the long felt need for a folding knife with a spring which will not succumb to fatigue or corrosion and does so in a manner which others have failed to do.

Conclusion

The Examiner’s rejection of Claims 1 and 2 is based on a combination of hindsight and use of improper legal standards. Poehlmann does not adequately disclose how one would

¹⁷ Examiner’s Answer, page 6.

¹⁸ See Declarations of Covert, Cutshaw, Karwan, and McCann.

¹⁹ See Declarations of Covers, , Karwan, and McCann and Statements of Breed and Larsen.

construct a gas spring comprising a movable wall that partially defines a substantially sealed, variable volume chamber containing a gas such that movement of a latch member from the locked position to an unlocked position causes the movable wall to reduce the volume of the chamber, thereby compressing the gas to create spring force against the latch member, as specified in the claims. The Examiner continues to use improper legal standards in his arguments for the rejection of this application, despite notification of the impropriety. Furthermore, the Examiner has dismissed substantial objective evidence of non-obviousness in the form of declarations and statements, simply because Applicant did not obtain such evidence from every single member of the knife design community. Accordingly, the Examiner must be reversed and the pending claims allowed.

Respectfully submitted,

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MEMORANDUM

DATE: May 3, 2007

TO: Technology Center Directors

FROM: *Margaret A. Focarino*
Margaret A. Focarino
Deputy Commissioner
for Patent Operations

SUBJECT: Supreme Court decision on *KSR Int'l. Co., v. Teleflex, Inc.*

The Supreme Court has issued its opinion in *KSR*, regarding the issue of obviousness under 35 U.S.C. § 103(a) when the claim recites a combination of elements of the prior art. *KSR Int'l Co. v. Teleflex, Inc.*, No 04-1350 (U.S. Apr. 30, 2007). A copy of the decision is available at <http://www.supremecourtus.gov/opinions/06pdf/04-1350.pdf>. The Office is studying the opinion and will issue guidance to the patent examining corps in view of the *KSR* decision in the near future. Until the guidance is issued, the following points should be noted:

- (1) The Court reaffirmed the *Graham* factors in the determination of obviousness under 35 U.S.C. § 103(a). The four factual inquiries under *Graham* are:
- (a) determining the scope and contents of the prior art;
 - (b) ascertaining the differences between the prior art and the claims in issue;
 - (c) resolving the level of ordinary skill in the pertinent art; and
 - (d) evaluating evidence of secondary consideration.

Graham v. John Deere, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966).

- (2) The Court did not totally reject the use of "teaching, suggestion, or motivation" as a factor in the obviousness analysis. Rather, the Court recognized that a showing of "teaching, suggestion, or motivation" to combine the prior art to meet the claimed subject matter could provide a helpful insight in determining whether the claimed subject matter is obvious under 35 U.S.C. § 103(a).

- (3) The Court rejected a rigid application of the "teaching, suggestion, or motivation" (TSM) test, which required a showing of some teaching, suggestion, or motivation in the prior art that would lead one of ordinary skill in the art to combine the prior art elements in the manner claimed in the application or patent before holding the claimed subject matter to be obvious.

(4) The Court noted that the analysis supporting a rejection under 35 U.S.C. § 103(a) should be made explicit, and that it was “important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” in the manner claimed. The Court specifically stated:

Often, it will be necessary . . . to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an **apparent reason** to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, this analysis **should be made explicit**.

KSR, slip op. at 14 (emphasis added).

Therefore, in formulating a rejection under 35 U.S.C. § 103(a) based upon a combination of prior art elements, it remains necessary to identify the reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed.